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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/820,853

04/09/2004

Kazuhisa Arai

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EXAMINER

CADUGAN, ERICA E

ART UNIT

PAPER NUMBER

3722

MAIL DATE

DELIVERY MODE

02/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/820,853

Applicant(s)

ARAI ET AL.

Examiner

Erica E. Cadugan

Art Unit

3722

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 5.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: PTO-892 Notice of References Cited.

Erica E Cadugan
Primary Examiner
Art Unit: 3722

Continuation of 11. does NOT place the application in condition for allowance because: In the present proposed amendment after-final, dependent claim 5 has been rewritten in independent form and includes all the limitations of claims 1 and 4 from which it previously depended. In the final rejection mailed 10/12/2006, claim 5 was rejected under 35 USC 103(a) as being unpatentable over U.S. Pat. No. 2002/0004359 to Arai in view of JP-2000-173954-A (hereinafter '954) and further in view of Applicant's Admitted Prior Art (hereinafter AAPA).

Applicant has asserted that the Examiner's asserted combination of references is "improperly based upon hindsight because neither Arai nor JP'954/Yukawa teaches or suggests that static electricity is generated therein, or that the generation of static electricity is a problem" and that "[I]n other words, neither Arai nor JP '954/Yuakawa provides any reason, suggestion or motivation to use the fluid supply means as asserted by the Examiner's because neither such document teaches that static electricity is generated therein, or that static electricity poses a problem". However, this is not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is noted that the Examiner's Official Notice set forth that it was well known in the art to provide the ionized air in a machining operation "in order to neutralize any static electricity created during the machining process", i.e., not only did the Examiner take (un-challenged) Official Notice that the use of ionized air in a machining operation was well-known, but took (again, unchallenged) Official Notice that the use of such for the purpose of neutralizing static electricity created during the machining process was known. In other words, one having ordinary skill in the art would be aware of the well-known benefit of neutralizing static electricity of a machining operation when ionized air is used. Additionally, whether or not either of the references explicitly teaches that static electricity is generated during the machining operation is immaterial to the fact that the generation of such static electricity inherently occurs when machining a resin workpiece, such as the resin workpiece taught by JP '954/Yukawa, as is evidenced by US Pat. Application Publication No. 2003/0119425 to Suzuki, for example (see paragraph 0035, which teaches that when cutting a resin material, the resin workpiece and the tool are brought into frictional contact with each other "thus generating static electricity having higher voltage", which "may cause that the chips are electrically charged and tend to adhere to the surface of the base" (workpiece) "and cutting part or parts" of the tool, and that "[T]o eliminate this drawback, the ionic fluid is blown to the vicinity of the cutting part(s), thus neutralizing the electrically charged chips", for example).

Additionally, regarding Applicant's assertions that "Yukawa does not teach or suggest cutting the bumps or electrodes themselves to make them uniform in height", firstly, it is noted that the present claim is an apparatus claim (not a method claim), and is directed to a "machine" having an intended use ("for processing electrodes formed on a plate-like workpiece...") of processing electrodes to make electrodes projecting from a front surface of the plate-like workpiece uniform in height.

Note that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, it is noted that the Yukawa machining device is capable of making electrodes project from a front surface of a plate-like workpiece uniform in height by providing a workpiece and controlling the cutting device appropriately, for example, by providing a workpiece wherein the electrodes project, and then moving the cutter so that they are all cut to the same height.

Further note that in the Yukawa patent, the bumps 11 project from a front surface of "plate-like workpiece" 10 (see Figure 9), and they are machined to be planar, and thus project from 10 at a "uniform" height, as is shown in at least Figure 9, for example (see Figure 2, noting that portions of 11 are machined away). In the event that Applicant is asserting that 11 are not electrodes and thus the claim language is not met, Examiner again notes that the claim is directed to an machine, and not a method, and that the machine has a claimed intended use of being "for processing electrodes formed on a plate-like workpiece to make electrodes projecting from a front surface of the plate-like workpiece uniform in height", and that the fact that Yukawa teaches that the bumps 11 which project from a plate-like workpiece can be machined to a uniform height is evidence that the machining device of Yukawa could perform the claimed intended use, noting that the tool is blind as to the workpiece on which it operates, and that the tool doesn't care whether or not the members 11 are electrodes.